



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,386	06/01/2001	John Edward Archibald JR.	SJ09-2000-0075-US1	2880

7590

02/09/2004

FLEHR HOHBACH TEST ALBRITTON & HERBERT LLP

Suite 3400

Four Embarcadero Center

San Francisco, CA 94111-4187

EXAMINER

TORRES, JOSEPH D

ART UNIT

PAPER NUMBER

2133

DATE MAILED: 02/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,386

Applicant(s)

ARCHIBALD ET AL.

Examiner

Joseph D. Torres

Art Unit

2133

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/14/2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,7-9,11-13,17-26,29,30,41 and 42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-13,17-26,29,30 and 41 is/are allowed.
- 6) ☒ Claim(s) 2,7-9 and 42 is/are rejected.
- 7) ☒ Claim(s) 42 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Drawings

1. In view of Amendment A of Paper No. 8, all objections to the drawings are withdrawn.

Specification

2. In view of Amendment A of Paper No. 8, all objections to the specification are withdrawn.

Claim Objections

3. Claim 42 is objected to because of the following informalities: on page 11 of the Applicant's response, the Applicant states that claim 42 is cancelled, but includes claim 42 as an original claim on page 10 of the response. Claim 42 must be properly cancelled on page 10. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2 and 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Newly amended claim 2 recites the limitation "the first said region" in line 11. There is insufficient antecedent basis for this limitation in the claim. Note: the newly added limitation to previously examined claims 1 and 2 make newly amended claim 2 incomprehensible.

Claims 7-9 depend from claim 2, hence inherit the deficiencies of claim 2.

Response to Amendment

5. Applicant's arguments with respect to amended claims 2 and 7-9 filed 14 November 2003 have been fully considered but they are not persuasive.

The Applicant contends, "The inventive element of claim 1 has been incorporated into independent claim 2".

The Examiner would like to point out that newly amended claim 2 bears no resemblance to previously examined claims 1 and 2 and the newly added limitation to claims 1 and 2 are incomprehensible as pointed out above in the ***Claim Rejections - 35 USC § 112*** section and cannot be examined on the merits at this point, hence only the limitations in previously examined claim 1 incorporated into newly amended claim 2 are examined at this point.

The Examiner disagrees with the applicant and maintains all rejections of amended claims 2 and 7-9. All amendments and arguments by the applicant have been considered. It is the Examiner's conclusion that amended claims 2 and 7-9 are not

patentably distinct or non-obvious over the prior art of record in view of the reference, Yamamuro, Mikio (US 5859823 A) as applied in the last office action, Paper No. 6. Therefore, the rejection is maintained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by Yamamuro, Mikio (US 5859823 A).

35 U.S.C. 102(b) rejection of claim 2.

Yamamuro teaches a method for testing a data storage medium for defects (col. 16, lines 37-49, Yamamuro, Note: Step 19 in Figure 20 of Yamamuro whereby CPU 50 determines that data is correctly recorded when the recorded data of each sector is compared with the reproduced data of each sector is a step for testing a data storage medium for defects), the method comprising: writing a data pattern to at least one predetermined region of the storage medium; reading back the written data pattern; comparing the data pattern written to the data pattern read back and identifying any error in the data (col. 16, lines 37-49, Yamamuro teaches that the recorded data of each sector is compared with the reproduced data of each sector to identify any error in the

Art Unit: 2133

data); if an error in the data was identified, then: identifying a defective region of the storage medium (col. 17, lines 18-25, Yamamuro, Note: the determination step S19 is a step for identifying a defective region of the storage medium referred to as a defective block in the Yamamuro patent); reallocating a new region of the storage medium (col. 14, lines 62-67, Yamamuro, Note: replacing an ECC block containing a secondary defective sector with a replacement ECC block using a linear replacement algorithm is a step for reallocating a replacement ECC block from the spare area, see Figure 3, Yamamuro); initializing the reallocated new region for access (col. 15, lines 1-7, Yamamuro, Note: recording data indicating that the linear replacement process has been effected in memory 10 is a step for initializing the reallocated new region for access); and replacing the defective region with the reallocated region before any further degradation occurs (col. 14, lines 62-67, Yamamuro, Note: replacing an ECC block containing a secondary defective sector with a replacement ECC block using a linear replacement algorithm is a step for replacing the defective region with the reallocated region before any further degradation occurs).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. Claim 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamuro, Mikio (US 5859823 A) in view of Fein, Ronald et al. (US 6565608 B1, hereafter referred to as Fein).

See Paper No. 6 for detailed action of prior rejections.

Allowable Subject Matter

8. Claims 11-13, 17-26, 29, 30 and 41 are allowed.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

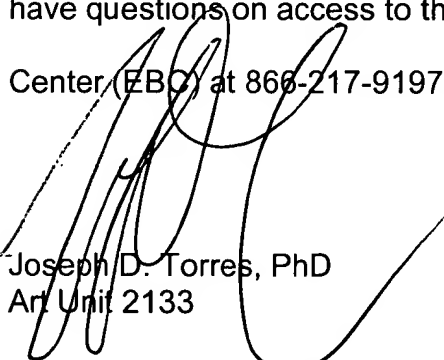
Art Unit: 2133

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

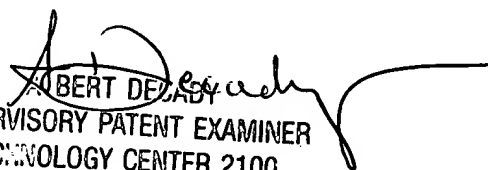
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph D. Torres whose telephone number is (703) 308-7066. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (703) 305-9595. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joseph D. Torres, PhD
Art Unit 2133



ALBERT DECADY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100